

REMARKS

Applicants have carefully considered the January 31, 2005 Office Action regarding the above-identified application, and the amendments above together with the remarks that follow are presented in a bona fide effort to respond thereto and address all issues raised in that Action. Applicants respectfully request favorable reconsideration and allowance of this application.

The independent claims have been amended to refer to a "shopping coupon," to distinguish over applied art that disclosed a "coupon card" representing a pre-purchased number of rides on a transit system. The "shopping coupon" appears in several of the drawings (see e.g. Figs. 4B, 5A and 5B). As will be readily understood by a person skilled in the art and in fact by the average American consumer, examples of shopping coupons include discount coupons and free item vouchers that typically are issued as incentives to entice potential customers to purchase goods or services or to make purchases from a particular establishment. It is respectfully submitted that the amendments to the claims to recite a "shopping coupon" do not introduce new subject matter or raise any issue regarding enablement or written description. As discussed in more detail, later, the amendments to the independent claims on the point clearly distinguish over the applied art and render all pending claims patentable over the art.

Claims 11-18 also have been amended to polish the language thereof. Although such other revisions may make some distinctions of the claims over the patent applied in the Office Action somewhat easier to appreciate, these other changes do not narrow the scope of the claims and in some cases may broaden the claim coverage.

An information disclosure statement (IDS) was filed October 6, 2003, and the Office Action included a copy of the document citation form (PTO-1449) from that IDS. However, the copy of the form included Examiner's initials only for the cited US patent and the two foreign patent publications. Although apparently considered, the literature document in the lower

portion of the citation form was not initialed. It is believed that a copy of the literature document was submitted with the IDS, and there should be a similar copy in the Patent Office file of the parent case. Further copies can be provided upon request. It is requested that the Examiner consider all of the documents cited in the IDS, as part of the reconsideration of this application, and that the Examiner indicate consideration by initialing the form alongside the citation of the literature document and returning the fully initialed document listing (PTO-1449) with the next Official communication regarding this case.

Applicants note the indication that the drawings filed with this continuation case are “considered informal,” but are otherwise sufficient for examination purposes. Formal drawings will be submitted upon receipt of a notice of allowability of all of the pending claims. However, the Office Action did not include a form PTO-948 from the draftsman indicating the nature of the drawing informality, and the detailed Action did not include any formality objection with respect to the drawings. Hence, Applicants can not readily determine the nature of the informality that needs correction. It is respectfully requested that the Patent Office provide the appropriate form indicating the drawing informality or otherwise explain the nature of the informality, in the next Official communication regarding this case.

The other issues raised in the Office Action relate to patentability of the claims over one applied patent document. Claims 11-18 were rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 5,877,484 to Hirose. This rejection is respectfully traversed.

All of the pending claims relate to a system or method “for broadcasting or transmitting a program or commercial message.” For example, each of the independent claims includes means for or a step involving “broadcasting or transmitting ... said program or commercial message.” A shopping coupon or information for use in requesting a shopping coupon is broadcast or transmitted “together with” the program or commercial message. The Hirose patent relates to an

automatic passenger gate system, using wireless cards to carry ticket information. It is respectfully submitted that the gate system of Hirose does not provide a system or method for broadcasting or transmitting a program or commercial message. Hence, the Hirose gate system does not include means for or a step involving broadcasting or transmitting a shopping coupon or coupon information together with a program or commercial message. Other elements of the claims also are missing. It is respectfully submitted there is no teaching that would motivate or lead one of skill in the art to modify the passenger gate system of Hirose to convert it to a system for broadcasting or transmitting a program or commercial message or to include the various elements of Applicants' claims. Hence, the claims patentably distinguish over Hirose. A more detailed discussion follows.

Although the rejection uses column and line number citation format, the rejection actually cites all of the summary and all of the detailed description in the Hirose patent, that is to say all of the text discussing the disclosed passenger gate system. The rejection, for example, does not explicitly identify a program or a commercial message or point out where or how the passenger gate system of Hirose broadcasts or transmits either a program or a commercial message.

Consider claim 11 as a first specific example. This independent claim recites "coupon information broadcasting/transmitting means for broadcasting or transmitting coupon information for use in requesting issuance of a shopping coupon together with said program or commercial message." The claim also recites "managing means for determining a period, a number of times or a fee, for broadcasting or transmitting said program or commercial message on the basis of said number of issuances of the shopping coupon." It is respectfully submitted that Hirose does not disclose either of these recited elements and there is no teaching that would lead a person skilled in the art to modify the gate system of Hirose to include such elements.

Hirose shows an automatic passenger gate that communicates with a wireless card (medium) storing riding information. The card serves as the passenger's ticket, in a transit system, such as a railway system. At the point where the passenger enters the transit system, an implementation of the gate receives the ticket-examining information from the wireless card and transmits riding information to the wireless card. Where the passenger exits the transit system (e.g. after riding the train), an implementation of the gate receives the ticket-examining information from the card, determines if the wireless card is valid based on the information and examines the type of the card. If the card is a stored-fare card (a kind of prepaid card), the gate transmits the updated balance (remaining amount after deduction of the fare for the latest ride) to the card. If the card is a coupon card or a season ticket card, the gate transmits the exiting information to the card. For example, the gate sends the reduced number of times of use remaining to the card (see e.g. column 6, lines 29-32). If the card needs to be collected, the gate collects the card. Attention also is directed to Figs. 5 and 6 of Hirose.

It is believed that the "coupon card" in Hirose means a card representing a number of rides on the transit system that the passenger purchases, and the number of remaining rides is reduced by one for each ride (one time of use) through the transit system. When used as such a "coupon card," the wireless ticket is an electronic analog to a paper book of tickets. The passenger buys the "coupon" tickets on the card and uses them to ride the transportation facility between the predetermined stations plural times. The passenger can save time by not having to buy a ticket each time the passenger uses the transit system.

By contrast, the coupon issued in claim 11 is a shopping coupon, e.g. a discount coupon or a voucher. A discount coupon, for example, often enables a user to buy something for a price that is discounted by the discount amount assigned to the coupon. It is respectfully submitted that the "coupon card" of Hirose is not a shopping coupon, therefore the ticket information sent

to the wireless card of Hirose is not information for use in requesting a shopping coupon. Hence, the system of Hirose does not include means for broadcasting or transmitting coupon information for use in requesting issuance of a shopping coupon, as recited in claim 11. The Hirose coupon card processing system also does not include “managing means for determining a period, a number of times or a fee, for broadcasting or transmitting said program or commercial message on the basis of said number of issuances of the shopping coupon,” as recited in claim 11. Nor is there any apparent teaching or suggestion to modify Hirose’s system to meet these claim requirements.

The Office Action alleges that coupon information broadcasting/transmitting means and broadcasting/transmitting managing means are disclosed in Hirose. However, that allegation is not correct.

As mentioned above, the entry gate of Hirose transmits only riding information to the wireless card, and the exit gate transmits only updated remaining amount or the exit information to the wireless card in Hirose. Hirose is silent on broadcasting or transmitting the program or commercial message with the riding information, the remaining amount or the exit information. Further, Hirose is silent on determining a period, a number of times or a fee for broadcasting or transmitting the program or commercial message, let alone determining such a parameter of communication based on the number of issuances of the coupon.

The automatic passenger gate of Hirose is mainly used in the public transportation systems, such as railway and subway systems. If the coupon ticket is issued (on which Hirose is relatively quiet), it relates to neither program nor commercial message. The system of claim 11 is mainly used for radio-wave broadcasting or the Internet broadcasting/delivery of programs and/or commercials. The sponsor of the program or commercial would like to know the effectiveness of the program message or the commercial message, and the sponsor typically pays

more for an advertisement associated with a more effective message. As disclosed, issuances of the shopping coupon provide a measure of effectiveness of the program or commercial with which the coupon information was associated. In the claim, the number of issuances is used to determine a period, a number of repetitions (times) or a fee, for the broadcasting or transmitting of the program or commercial. Hence, the transmission means of Hirose do not literally (explicitly or by any theory of inherency (implicitly) satisfy the requirements regarding (1) the means for broadcasting or transmitting coupon information together with a program or a commercial message; or (2) the means for determining a period, a number of times or a fee, for broadcasting or transmitting the program or commercial message based on number of coupon issuances.

The Examiner recognizes that Hirose fails to disclose coupon issuance number receiving means. The rejection of claim 1 alleges, however, that “it would have been obvious ... that Hirose ... shows” elements including those means, “because modification and interpretation of the cited disclosure of Hirose would have provided ‘*automatic ticket-examining ...*’ based on the motivation to modify Hirose ‘*for collecting one time use wireless tickets*’ ... ” (emphasis in original). This statement of obviousness is based on circular logic, which bears no relationship to the issue of obviousness of claim 11. Hirose, not the claim, relates to ‘automatic ticket-examining.’ Hirose discloses collecting wireless tickets when used-up, so modification or re-interpretation is not necessary. Also, the claim element in question relates to receiving a number regarding coupon issuances from a service center, which has nothing to do with either automatic ticket examining or collecting one time use wireless tickets. It is respectfully submitted that the explanation of the rejection does not show any rational basis for concluding that it would have been obvious to modify the public transportation passenger gate of Hirose to invent a

broadcasting or transmitting system as in claim 11, even if Hirose and claim 11 are considered to both relate to a “coupon.”

The factual issues underlying any rejection for obviousness relate to: what is taught by the art, what is claimed that is not taught by (the difference over) the principle reference, what, if any secondary teaching is relevant to the difference, and what if anything would lead a skilled artisan to modify or combine teachings to approach the claimed subject matter. The burden is on the Office, and thus on the Examiner, to present clear factual evidence supporting all necessary elements of the prima facie case of obviousness. See e.g. *In re Lee*, , 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (obvious determination vacated for lack of evidentiary support for conclusory statements regarding obviousness to select and combine); and *In re Zurko*, 258 F. 3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001) (deficiencies of the cited references cannot be remedied by general allegations of “basic knowledge” or “common sense”).

In this case, the Examiner has presented no evidence that the elements of Hirose inherently satisfy the actual requirements or claim 11. The Examiner also has failed to identify a secondary teaching or any relevant motivation to modify the Hirose system to meet claim 11. Modifying or interpreting “automatic ticket-examining ...” means of Hirose “for collecting one time use wireless tickets” is not a motivation that would actually lead a person skilled in the art to modify Hirose to produce the program or commercial communication system of claim 11. Absent citation of appropriate evidence on these points, the art rejection of claim 11 is improper, for failure to show obviousness under the relevant legal precedents, and should be withdrawn.

It is therefore submitted that Hirose does not disclose the elements or functions thereof recited in claim 11, there is no secondary teaching of any relevance on the points of distinction, and the rejection has failed to show any rational motivation for modifying Hirose to meet claim

11. Hence, claim 11 patentably defines over the Hirose patent. New claims 19-21 depend from claim 11 and should be patentable for at least the same reasons.

Claim 12 is a method claim. Claim 12, however, specifies broadcasting or transmitting coupon information for use in requesting issuance of a shopping coupon. The coupon information is broadcast or transmitted together with the program or commercial message. Claim 12 also recites receiving a number representing issuances of the shopping coupon, from a service center managing number of issued coupons for each program or commercial message. As noted above, Hirose does not send (broadcast or transmit) information about a shopping coupon, and Hirose does not send coupon information together with a program or a commercial. Hirose also does not provide a number representing issuances of the shopping coupon, from a service center. There is no suggestion that would lead one skilled in this art to modify Hirose's operations to provide these claimed method steps.

Claim 12 also specifies broadcasting or transmitting the program or commercial until the number of coupon issuances reaches a predetermined number. It is not seen where Hirose correlates issuances of a coupon with transmissions of a program or commercial. Hence, there is no disclosure of this additional method step. Applicants also submit that there is no teaching or motivation to modify Hirose on this point.

The rejection treated claim 12 as "rejected for substantially the same reasons as claim 11." As noted above, the rejection of claim 11 clearly fails to satisfy the requirements for a prima facie case in support of an allegation of obviousness and is therefore improper.

For at least the reasons outlined above, claim 12 should be patentable over Hirose and the rejection of claim 12 should be withdrawn.

Each of the other independent claims includes different combinations of the features discussed above that distinguish over Hirose and support a conclusion of patentability.

For example, each of claims 13-18 specifies broadcasting or transmitting a program or commercial message. Claims 13, 14, 17 and 18 specify broadcasting or transmitting a shopping coupon with the program or commercial message, whereas claims 15 and 16 specify broadcasting or transmitting coupon information with the program or commercial message wherein the coupon information is for use in requesting issuance of a shopping coupon. Hirose does not teach broadcasting or transmitting a program or commercial message, and Hirose does not teach sending either a coupon or coupon information together with the program or commercial message. For reasons similar to those discussed above, it would not have been obvious to modify Hirose to meet these claim requirements, and the rejection is claims 13-18 does not meet the requirements of a prima facie showing of obviousness. Hence, claims 13-18 also should be patentable over Hirose, and dependent claims 22-27 should be patentable therewith.

Claims 13-18 also specify further distinctions. For example, claims 13, 15 and 17 specify determining a period, a number of times or a fee, for the broadcast or transmission of the program or commercial message. In claims 13 and 17, the determination is based on number uses of the shopping coupon. In claim 15, the determination is based on issuances of the shopping coupon. Claims 14, 16 and 18 specify broadcasting or transmitting a program or commercial message until a number is reached. In claims 14 and 18, broadcasting or transmitting ends when the number of uses of the shopping coupon reaches a predetermined number; whereas in claim 16, the broadcasting or transmitting ends when the number of issuances of the shopping coupon reaches a predetermined number. It is believed that Hirose does not teach any of these further claim requirements, and modification of Hirose to meet these further requirements would not have been obvious in the sense of 35 U.S.C. § 103. Hence, for this additional reason, claims 11-18 and 22-27 should be patentable.

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Upon entry of the above claim amendments, claims 11-27 should be active in this application, all of which should be in condition for allowance. Accordingly, this case should now be ready to pass to issue; and Applicants respectfully request a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the January 31, 2005 Office Action. However, if any further issue should arise that may be addressed in an interview or an Examiner's amendment, it is requested that the Examiner telephone Applicants' representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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